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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,782	11/05/2001	Nobukazu Kurauchi	NAKI-BQ35	7519
21611 7590 02/02/2007 SNELL & WILMER LLP 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			EXAMINER VU, NGOC K	
			ART UNIT 2623	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/02/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/010,782

Applicant(s)

KURAUCHI ET AL.

Examiner

Ngoc K. Vu

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17 and 24-29 is/are allowed.
- 6) ☒ Claim(s) 18 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/5/01, 11/14/03, 8/28/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2. Claims 22 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Regarding claims 22-23 define a computer program embodying functional descriptive material. However, there are not any structural and functional interrelationships between computer program and other claimed elements of a computer which permit the computer program's functionality to be realized, and is thus non-statutory for that reason. Moreover, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized"). Any amendment to the claim should be commensurate with its corresponding disclosure. The examiner suggests amending the claim language in computer-processing related feature or equivalent in order to make the claim statutory. For example, claims 22 and 23 should change "a computer program..." and "a recording program..." to **--a computer readable medium encoded with instructions capable of being executed by a computer to perform....--** in the preambles.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2623

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US 6,314,573 B1) in view of Son et al. (US 7,159,235 B2) and further in view of Swix et al. (US 6,718,551 B1).

Regarding claim 18, Gordon teaches a method for transmitting/receiving broadcast program by which a pay broadcast program is transmitted to one of plurality of viewer's terminal (106 – figure 1), the method comprising the steps of: receiving a transmission request for a pay broadcast program list (e.g., title menu) from the viewer's terminal (106), the list includes titles of pay broadcast programs thereon (figures 5-6) (see col. 4, lines 52-55 and figure 3B); transmitting the pay broadcast program list to the viewer's terminal (col. 4, lines 52-55; col. 5, lines 9-13 and 32-35); receiving a request for a pay broadcast program whose title is listed on the pay broadcast program list from viewer's terminal (e.g., when a viewer selects a title from a title menu, the title selection is sent to video session manager 122 from terminal 106. See figure 1; col. 9, lines 27-29).

Gordon does not explicitly teach transmitting a request for the requested pay broadcast program to a pay broadcast program site and receiving the pay broadcast program from the pay broadcast program site. However, Son discloses that when a requested content is not in local stream caching server 102 in local head-end, the system manager 140 identifies a remote stream caching server 202 that stores the requested program content and then provides a server request to the remote system manager 204. In response to the server request, the remote stream caching server 202 streams the requested program content over the stream distribution network 104 to the local stream caching server 102. (See figure 2 and col. 10, lines 32-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 2623

invention was made to modify the system of Gordon by transmitting a request for a requested program to a remote server and receiving the requested program from the remote server as taught by Son in order to efficiently provide reduce cost of providing program content and to efficiently accommodate multiple access networks.

The combined teaching of Gordon and Son does not include inserting stored commercial into the received broadcast program to produce a broadcast program with commercials and transmitting the broadcast program with commercials to the viewer's terminal. However, Swix discloses inserting targeted advertisements from advertisements stored in file server into a broadcast program. For example, when a viewer orders the feature movie presentation, the pay-per-view service prepares to send the movie along with the commercials that will precede and follow the movie. See col. 12, lines 1, lines 3-19, 47-63. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Gordon and Son by transmitting the broadcast program with inserted commercials to the viewer's terminal as taught by Swix in order to efficiently provide targeted advertising corresponding to viewer purchasing interests.

Regarding claim 21, the combined teaching of Gordon, Son and Swix teaches transmitting the request for service/program, transmitting the broadcast program with commercials and determining whether the subscriber is authorized to access to the system. For example, the session manager validates the PIN and TID authorization by comparing the transmitted TID and PIN to a PIN and TID stored in the session manager memory. (See Gordon: col. 5, lines 13-16; col. 8, lines 12-16 and 25-28; col. 8, line 67 to col. 9, line 7; Swix: see col. 12, lines 1, lines 3-19, 47-63).

Regarding claim 22, Gordon teaches a computer program (e.g., software or instructions) that makes a computer (e.g., processor) execute a method for transmitting/receiving broadcast

program by which a pay broadcast program is transmitted to one of plurality of viewer's terminal (106 – figure 1), the computer program has the computer conduct the steps of: receiving a transmission request for a pay broadcast program list (e.g., title menu) from the viewer's terminal (106), the list includes titles of pay broadcast programs thereon (figures 5-6) (see col. 4, lines 52-55 and figure 3B); transmitting the pay broadcast program list to the viewer's terminal (col. 4, lines 52-55; col. 5, lines 9-13 and 32-35); receiving a request for a pay broadcast program whose title is listed on the pay broadcast program list from viewer's terminal (e.g., when a viewer selects a title from a title menu, the title selection is sent to video session manager 122 from terminal 106. See figure 1; col. 9, lines 27-29).

Gordon does not explicitly teach transmitting a request for the requested pay broadcast program to a pay broadcast program site and receiving the pay broadcast program from the pay broadcast program site. However, Son discloses that when a requested content is not in local stream caching server 102 in local head-end, the system manager 140 identifies a remote stream caching server 202 that stores the requested program content and then provides a server request to the remote system manager 204. In response to the server request, the remote stream caching server 202 streams the requested program content over the stream distribution network 104 to the local stream caching server 102. (See figure 2 and col. 10, lines 32-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Gordon by transmitting a request for a requested program to a remote server and receiving the requested program from the remote server as taught by Son in order to efficiently provide reduce cost of providing program content and to efficiently accommodate multiple access networks.

The combined teaching of Gordon and Son does not include inserting stored commercial into the received broadcast program to produce a broadcast program with commercials and

Art Unit: 2623

transmitting the broadcast program with commercials to the viewer's terminal. However, Swix discloses inserting targeted advertisements from advertisements stored in file server into a broadcast program. For example, when a viewer orders the feature movie presentation, the pay-per-view service prepares to send the movie along with the commercials that will precede and follow the movie. See col. 12; lines 1, lines 3-19, 47-63. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Gordon and Son by transmitting the broadcast program with inserted commercials to the viewer's terminal as taught by Swix in order to efficiently provide targeted advertising corresponding to viewer purchasing interests.

Regarding claim 23, Gordon teaches a recording medium that is readable for a computer, the recording medium recording a computer program (e.g., software or instructions) that makes a computer (e.g., processor) execute a method for transmitting/receiving broadcast program by which a pay broadcast program is transmitted to one of plurality of viewer's terminal (106 – figure 1), the computer program embodied on the recording medium has the computer conduct the steps of: receiving a transmission request for a pay broadcast program list (e.g., title menu) from the viewer's terminal (106), the list includes titles of pay broadcast programs thereon (figures 5-6) (see col. 4, lines 52-55 and figure 3B); transmitting the pay broadcast program list to the viewer's terminal (col. 4, lines 52-55; col. 5, lines 9-13 and 32-35); receiving a request for a pay broadcast program whose title is listed on the pay broadcast program list from viewer's terminal (e.g., when a viewer selects a title from a title menu, the title selection is sent to video session manager 122 from terminal 106. See figure 1; col. 9, lines 27-29).

Gordon does not explicitly teach transmitting a request for the requested pay broadcast program to a pay broadcast program site and receiving the pay broadcast program from the pay broadcast program site. However, Son discloses that when a requested content is not in local

Art Unit: 2623

stream caching server 102 in local head-end, the system manager 140 identifies a remote stream caching server 202 that stores the requested program content and then provides a server request to the remote system manager 204. In response to the server request, the remote stream caching server 202 streams the requested program content over the stream distribution network 104 to the local stream caching server 102. (See figure 2 and col. 10, lines 32-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Gordon by transmitting a request for a requested program to a remote server and receiving the requested program from the remote server as taught by Son in order to efficiently provide reduce cost of providing program content and to efficiently accommodate multiple access networks.

The combined teaching of Gordon and Son does not include inserting stored commercial into the received broadcast program to produce a broadcast program with commercials and transmitting the broadcast program with commercials to the viewer's terminal. However, Swix discloses inserting targeted advertisements from advertisements stored in file server into a broadcast program. For example, when a viewer orders the feature movie presentation, the pay-per-view service prepares to send the movie along with the commercials that will precede and follow the movie. See col. 12, lines 1, lines 3-19, 47-63. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Gordon and Son by transmitting the broadcast program with inserted commercials to the viewer's terminal as taught by Swix in order to efficiently provide targeted advertising corresponding to viewer purchasing interests.



***Allowable Subject Matter***

6. Claims 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 1-17 and 24-29 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of the record fails to teach or fairly suggest the limitations "a plurality of commercials information management sites...and transmits the pay broadcast program with one or more commercials to the viewer's terminal" as recited in claim 1; "a judgement unit...the delivery form being utilized for the judgement" and "a pay broadcast program transmission unit...that has requested the pay broadcast program" as recited in claim 24; "transmitting counting unit...for each pay broadcast program/commercial" as recited in claim 25; and "redemanding unit...with the received identifying information" as recited in claim 29.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



NGOC K. VU  
PRIMARY EXAMINER  
Art Unit 2623

February 1, 2007